

RECEIVED
AUG 05 2003
TC 1700

#38/03
11/3/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit: 1754
Examiner: T. Vanoy

In re Patent Application of:

Applicants : Nilo FAGIOLINI et al.)

Appln. No. : 09/423,746)

Filed : November 15, 1999)

REPLY BRIEF

For : REACTIVE POWDER COMPOSITION
AND METHOD FOR PURIFYING GAS)

Customer No.

26694

Atty. Dkt. : 32232-152197)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper [filed in triplicate] is presented in response to the Examiner's Answer.

Applicants note that the Main Brief at pages 2 and 3 contains a section heading entitled Related Appeals and Interferences.

REMARKS

Applicants address the citation of case law in the PTO Brief [Examiner's Answer]:

In re Petering, 301 F.2d 676 ;133USPQ 275 at 280 (CCPA 1974); In re Kuhle 526 F.2d 533, 188USPQ 7 (CCPA 1975); In re Larson 340 F2d 965 144USPQ 347 (CCPA 1965); Ex parte Wu 10USPQ 2d 2031 (Bd. Pat. App. & Int.1989).

Noted
WAL
12-2-03

I. THE CLAIMS ON APPEAL-ARE REJECTED UNDER 35 U.S.C.

103, NOT UNDER 35 U.S.C. 102

In re Petering [301 F.2d 676 ;133USPQ 275 at 280 (CCPA 1974)] as enunciated by the court at page 133 USPQ 275, 280 [paragraph no. 6, PQ edition] is directed to an issue relating to the identity of claimed compounds vis-à-vis the prior art disclosure—under 35 U.S.C. 102--, not to a question of obviousness. [Cf. This was clearly noted by the PTO in the Paper at page 7 dated December 10, 2001 on the last page 9

Accordingly, citation of In re Petering appears to be irrelevant.

II. COMPOSITION AND PROCESS OF PURIFICATION OF GASES WITH THAT COMPOSITION.—THE INVENTION AS A WHOLE

Claim 1 refers to a composition which contains a caking inhibitor; is "devoid of silica"; and is characterized by specific particle size. The claim 12 preamble refers to a "**non-caking composition**" containing inter alia that caking inhibitor and being "devoid of silica". These compositions are improvements and can be used in the same processes as silica containing counterparts. The language "devoid of silica" addresses the problem of agglutination and caking of sodium bicarbonate and the adhesion of solid wastes, from scrubbed gases, to filter cloths [please see page 4 of the main BRIEF].

In summary, (a) there is no teaching and the U.S. PTO has presented no rationale to arrive at the present invention "**devoid of silica**"; and (b) there is no teaching in the references, and the PTO has cited no evidence that relates to agglutination and filter cloths, or that would lead one to eliminate silica from the compositions in the Regler reference:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

III. THE FACTS IN THIS CASE

Regler states

"A particularly preferred embodiment of the method is characterized in that mixtures of the cited basic alkali and/or alkaline earth compounds and surface-active substances are used. The surface-active substances are activated charcoal, activated coke, for example, brown hearth furnace coke, activate aluminum oxide, **silica gel**, kieselgur, and/or zeolites.

When using such mixtures, substantial advantages are produced..."[page 4 of the translation (emphasis added)]

Here appellants' claims exclude silica; whereas, Regler indicates that silica gel is one of reagents which is efficacious as a surface-active agent.

In Wu [Ex parte Wu, 10USPQ 2d 2031 (Bd. Pat. App. & Int.1989)], method claims contained the language "**consisting of**"; the Board found and held that the reference to:

"Murdock teaches that these salts are beneficial when the composition is employed in contact with fresh water...**Omission of the salt component..in environments which do not encounter fresh water would have obvious**" [at 2032]

The fact situation is different in the case on appeal: Appellants composition claims are different in physical properties over those composition (s) containing silica. Applicants claim compositions "devoid of silica" relate to language in the preamble of

the Claim 12 on appeal, which refers to "non-caking". Regler refers neither to caking caused by silica nor to filter cloths.

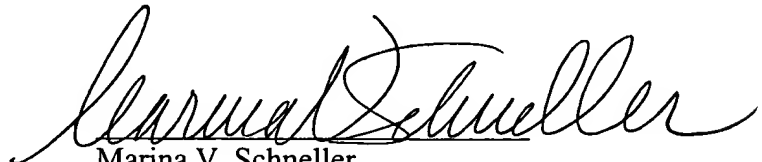
In the Larson and Kuehl cases, claims on appeal related (1) to a wheel hub in a vehicle and (2) to an electrical instrument for measuring conductivity of soil. In each case, certain claims related to a structure in which elimination of an element of the prior art structure respectively was held to remain within the skill of the art. In the Larson case applicant/appellant claims eliminated certain "additional framework"; the Court stated,

"the added structure.. serves a particular purpose...it would seem a matter of obvious choice to eliminate it and the function it serves [because the LeClair reference] specifically states that the axle assembly may comprise "either a single axle or two axles fixed in an axle tube..."[144 USPQ at 350]

In Kuhle, the applicant/appellant elimination of a switch requirement of the prior art structure, without alteration of function of the claimed device, was held to be "obvious" when its operation was the same as the prior art structure [188 U.S.P.Q. at 9]

Reconsideration and an early allowance are respectfully solicited..

Respectfully submitted,



Marina V. Schneller
Registration No. 26,032
Venable, LLP
Post Office Box 34385
Washington, D.C. 20043-9998
Phone: (202) 962-4800
Fax: (202) 962-8300

August 1, 2003
Date